

Attorney Docket No. 10139/02002(00183-05PUS1)

REMARKS

Claims 19-40 remain pending in the above-referenced application. No amendments have been submitted for entry.

Claims 19-40 stand rejected under 35 U.S.C. § 103(a) as unpatentable in view of United States Patent No. 5,032,125 to Durham et al. ("Durham") and/or as unpatentable over Durham in view of one or more of Lawes, Bramlet, Fixel, Bresina, and Frigg. The Examiner has not been persuaded by Applicants' argument basing patentability on the absence in Durham of a sliding sleeve that is "configured to receive the shaft of the bone fixation element while permitting free rotation of the bone fixation element relative to the sleeve," as recited in claim 19. A similar limitation appears in claim 37.

Durham unquestionably lacks this feature. The Examiner does not dispute its absence. Instead, the Examiner contends that despite the absence of this limitation in Durham, one of ordinary skill in the art, at the time of the claimed invention, would have been able to arrive at the claimed invention. Specifically, the Examiner asserts that the transforming of flat surfaces 44 of the sleeve bore 42 and flat surfaces 66 of body member 62, which the Examiner does not argue can achieve the "free rotation" of the claims, into circular surfaces permitting such free rotation is well within the ability of one of ordinary skill in the art. No evidence in the form of another reference or publication is offered to support the contention that Durham could be modified so that the sleeve 40 is changed to permit the free rotation of the inserted lag screw 60. Indeed, the presence of flat surfaces 44, 66 is strong evidence that Durham teaches away from permitting such free rotation. Since the flat surfaces 44, 66, achieve precisely the opposite effect of free rotation, the contention that Durham would nevertheless have supported a modification to achieve such free rotation is suspect.

In answer to the question of why would Durham, the only evidence relied on by the Examiner to reject the free rotation aspect of the claims, have prompted one of ordinary skill in the art to make this modification is answered by the Examiner with only an unfounded rationale: since "Durham does not disclose that the prevention of rotation of the screw in the sleeve is a critical function of the device" (Final Office Action at page 8), then one of ordinary skill in the art would have recognized this modification. Under the Examiner's theory of obviousness, an Applicant can legitimately distinguish a reference only on the basis of those features identified explicitly in the reference as "critical." If an Applicant says that the reference does not have a

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particular feature, and that reference expressly identifies this feature as critical, then the Applicant should expect to receive a patent under the Examiner's view of obviousness. On the other hand, if an Applicant finds that the reference differs from the claim with respect to a particular feature that is not expressly identified as critical, which in the Examiner's mind somehow means that it is non-critical, then the Examiner is free to argue that this supposedly non-critical feature in the reference can be modified in whatever way the Examiner wishes in order to arrive at the claimed invention, even if he must completely eviscerate the purpose of the particular non-critical feature in the reference. That is quite an idiosyncratic take on the law of obviousness, especially since a feature of a reference can be correctly characterized as critical even if the reference does not use the word "critical" to characterize its importance. Indeed, this view is so unconventional that Applicants would be remiss if they did not request that the Examiner cite to some authority that is directly on point in supporting the rationale applied here. Specifically, is there some law, regulation, or judicial authority that empowers an Examiner to wave off any non-obviousness argument simply on the assertion that the reference on which the rejection is based fails to characterize the distinguishing feature in the reference as "critical"? Even more curious is the contention, made at page 2 of the Final Office Action, that since Durham never states that the flat surfaces 44, 66 are necessary for the Durham device to operate properly, a surface with a circular cross-section could be used. Is there any authority to which the Examiner can cite that justifies such a non sequitur? What if the claim recited some oily or other slippery substance to achieve this free rotation? Would the alleged non-criticality of the flat surfaces in Durham have justified the Examiner in regarding such a substance as obvious too? Apparently, it would not be unfair to characterize the logical implication of the Examiner's position by stating that any conceivable way to achieve this free rotation is within the grasp of one of ordinary skill in the art. What makes this position even more untenable is that it is based on a reference that teaches the precise opposite, that teaches instead the prevention, not the facilitation, of such free rotation through the presence of complementary flat surfaces 44, 66. Applicants do not dispute that the flat surfaces 44, 66 could be modified in some way consistent with the knowledge of one of ordinary skill in the art, but any such modification to these surfaces must preserve the rotation prevention achieved by them. For instance, the flat surfaces 44, 66 could be modified into some non-flat, yet interlocking, complementary surfaces that preserve their locking ability. On the other hand, a modification to these surfaces such as the one the

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Examiner proposes undermines this rotation prevention aspect of Durham solely for the purpose of meeting the claim limitation. Unless there is some pre-filing evidence that supports such a modification, the Examiner is engaging in nothing but hindsight to arrive at the claimed invention.

As for the "locking mechanism" and "sliding sleeve" limitations, Applicants submit the arguments made in the prior response. Moreover, Applicants submit that none of Lawes, Fixel, Bresina, and Frigg overcome the deficiencies noted above in Durham.

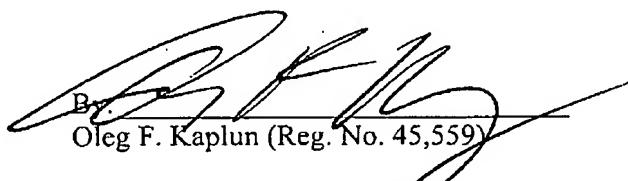
All the issues raised by the Examiner having been addressed, Applicants submit that this application is in condition for allowance.

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**CONCLUSION**

In view of the remarks submitted above, the Applicants respectfully submit that the present case is in condition for allowance. All issues raised by the Examiner have been addressed, and a favorable action on the merits is thus earnestly requested.

Respectfully submitted,

Dated: October 22, 2007  
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